

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-71 are pending. Claims 60-71 are withdrawn as directed to non-elected subject matter. Applicant notes that the Office Action Summary incorrectly states that only claims 1-59 are pending and that no claims are withdrawn. Applicant respectfully requests that the Examiner correct this oversight. No claim is amended in this response.

Applicant respectfully acknowledges the Examiner's withdrawal of the rejection of claims 1-59 under 35 U.S.C. § 103 over the combination of U.S. Patent Nos. 4,927,627 (the '627 patent) and 6,902,722 or 6,955,803 or 7,045,120 in light of the perfection of priority and of the rejection of claims 1-59 under 35 U.S.C. § 103 over the combination of the '627 patent and U.S. Patent Nos. 6,287,543 or 6,630,131 in view of remarks made in the Response to Office Action filed October 29, 2007. See Office Action at 2.

II. REJECTIONS UNDER 35 U.S.C. § 103

A. Rejection under 35 U.S.C. § 103(a) over '627 in view of PG PUB '015

The Examiner maintains the rejection of claims 1-59 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of U.S. Patent 4,927,627 ('627) and U.S. Application Publication No. 2004/0074015 (PG PUB '015), also referred to as U.S. Application No. 10/451,409 ('409) elsewhere in the Office Action. See Office Action at 2-3. Applicant respectfully traverses for at least the following reasons.

1. Background

With regard to the '409 application, the Examiner recognized in the Office Action dated June 29, 2007, that

[c]ommonly assigned 10/451,409 . . . would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 C.F.R. 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

June 29, 2007 Office Action at 9.

In the reply dated October 29, 2007, Applicant stated at page 10 that "[t]he present cases are indeed commonly assigned to L'Oreal and were at the time of invention. In the present application, an assignment to L'Oreal was recorded on April 6, 2004, at Reel 015182, Frame 0202. In the '409 application, an assignment to L'Oreal was recorded on December 1, 2003, at Reel 014745, Frame 0850." (Emphasis added).

In the Office Action dated December 13, 2007, the Examiner asserts that "Applicants do not state 'Application X (instant) and PG PUB were at the time the invention of application X was made owned by company L'Oreal.' See MPEP 706.02(l)(2) section II." Office Action at 3.

Regarding the evidence required to establish common ownership, M.P.E.P.

706.02(l)(2) states:

In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

“Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z.”

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

Applicant submits that such a statement was made in the previous reply, as noted above. However, in the interest of advancing prosecution, Applicant repeats the statement below.

2. Statement of Common Ownership

U.S. Patent Application No. 10/690,563 and U.S. Patent Application Publication No. 2004/0074015 were, at the time the invention of U.S. Patent Application No. 10/690,563 was made, commonly owned by L'Oréal.

In view of the above, PG PUB '015 cannot properly be used in a rejection of the instant claims under 35 U.S.C. § 103(a). Further, as acknowledged by the Examiner, the '627 patent alone does not teach or suggest the presently claimed invention. See Office Action at 2-3. Accordingly, the rejection of the instant claims under 35 U.S.C. § 103(a) over the combination of the '627 patent and PG PUB '015 has been overcome and should be withdrawn.

B. Rejection under 35 U.S.C. § 103(a) over '627 in view of '476 and '118

In the Office Action, the Examiner rejects claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 4,927,627 ('627), U.S. Patent No. 6,645,476 ('476), and U.S. Patent No. 6,180,118 ('118). Applicant respectfully traverses for at least the following reasons.

With respect to obviousness, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Indeed, to establish a *prima facie* case of obviousness, the examiner must:

make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight

must be avoided and the legal conclusion must be reached
on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). “The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” *Id.* It is important to note, moreover, that the prior art references relied upon in a rejection “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” when such reasons are articulated by the Examiner. *Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467; *See also* M.P.E.P. § 2141.03(VI) (emphasis added).

Applicant respectfully submits that such reasons are not present in the rejection of record at least because the references relied upon by the Examiner, when considered as a whole, provide no reason that would have prompted a person of ordinary skill in the art to modify and combine the references in the manner suggested by the Examiner. In fact, for the reasons set forth below, Applicant submits that the references, when considered in their entirety, include portions that would discourage the modification and combination suggested by the Examiner.

The Examiner states that the ‘476 patent “teaches compositions comprising a copolymer wherein one comonomer is acrylamido propyl methyl sulfonic acid (AMPS) or its salts (elected ethylenically unsaturated monomer containing sulfonic group[]), and one or more macro monomers are chosen from esters of methacrylic acid with alkyl ethoxylates which include 5-80 ethylene oxide units and 10-22 carbon alkyl radicals.” Office Action at 6-7. The Examiner further states that the ‘118 patent teaches compositions comprising an amphiphilic polymer which the Examiner asserts “shares close structural similarity having the same ethylenically unsaturated monomer and it is

cross linked with the cross linking agent.” *Id.* at 8. In asserting that the amphiphilic copolymers of the ‘476 and ‘118 patents are similar, the Examiner fails to consider that the cited references, when considered in their entirety, teach that their respective copolymers differ significantly.

First, Applicant notes that the ‘118 patent teaches crosslinked poly(2-acrylamido-2-methylpropanesulfonic acid) polymers (AMPS polymers) but does not disclose polymers according to the ‘476 patent for at least the reason that the ‘118 patent does not disclose AMPS polymers comprising “a hydrophobic moiety which comprises hydrogen or a saturated or unsaturated, linear or branched, aliphatic, cycloaliphatic or aromatic (C₁-C₃₀)-hydrocarbon radical.” ‘476 patent at Claim 1, *see also* Abstract. Applicant also notes that the ‘118 patent does not teach polymers according to the present claims for at least the reason that the ‘118 patent does not disclose AMPS polymers comprising at least one hydrophobic unit comprising from 6 to 50 carbon atoms. *See, e.g.*, present claim 1.

Not only does the ‘118 patent not disclose AMPS polymers according to the ‘476 patent, it would also be clear to one of ordinary skill in the art that the ‘476 and ‘118 patents are directed to polymer particles of vastly different sizes. The ‘476 patent teaches that in a **representative** embodiment of its invention, 97.4% of the polymer particles are bigger than **45,000 nm** (45 micrometers).¹ Thus, AMPS copolymers

¹ The ‘476 patent teaches that “[a] **representative** favorable size distribution is the following particle size distribution, as was determined by screen analysis for an AMPS copolymer: 60.2% smaller than 423 micrometers, 52.0% smaller than 212 micrometers, 26.6% smaller than 106 micrometers, **2.6% smaller than 45 micrometers** and 26.6% larger than 850 micrometers.” ‘476 patent at col. 5, lines 4-9 (emphasis added).

according to the '476 patent would be entirely unsuitable for use in compositions according to the '118 patent, which teaches the use of polymer particles no larger than **500 nm**.² Even if some tiny fraction of AMPS copolymers according to the '476 patent were smaller than 500 nm, AMPS copolymers according to the '476 patent would still fail to display a homogeneous and unimodal size distribution, as required by the '118 patent. Accordingly, one of ordinary skill in the art would recognize that the '118 and '476 patents are directed to polymer particles which differ greatly not only in their chemical nature, but also in their size, and would thus be expected to have different properties. As a result, one of ordinary skill in the art would not consider the polymers of the '118 and '476 patents similar.

The Examiner further asserts that "[o]ne of ordinary skill in the art would have reasonable expectation of success that substituting thickener of ['627] with the thickener of '476 would yield the same predictable results and patent '118 clearly suggests that the combination of amphiphilic polymer of '476 and hydrogen peroxide would yield transparent and gel and these gels being stable on storage." Office Action at 8.

Applicant respectfully traverses for at least the following reasons.

Applicant submits that the '118 patent would not have provided one of ordinary skill in the art with any expectation for success in combining elements from the '627 and '476 patents since the '118 and '476 patents are directed to dissimilar polymers with

² The '118 patent teaches that "the polymers of the invention contain a number of units of formula (1) in a sufficiently large amount to obtain polymer particles whose hydrodynamic volume in aqueous solution has a radius ranging from **10 to 500 nm** and **whose distribution is homogeneous and unimodal**." '118 patent at col. 3, lines 17-21 (emphasis added), see *also* Claim 3 of the '118 patent.

divergent properties, as set forth above. In fact, the '118 patent teaches against combining the '627 patent (which is directed to oxidizing compositions) and the '476 patent (which is silent on oxidizing compositions) by teaching that AMPS polymers of use in oxidizing compositions are distinctly different from the AMPS copolymers disclosed by the '476 patent. Furthermore, the combination of elements from the '627 and '118 patents alone would also not enable one of ordinary skill in the art to prepare compositions according to the instant claims since neither of these references teaches or suggests copolymers of AMPS units and hydrophobic units.

In view of the above arguments, Applicant submits that the rejection of claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the '627, '476, and '118 patents is in error and should be withdrawn.

III. PROVISIONAL DOUBLE PATENTING REJECTION

In the Office Action, the Examiner provisionally rejects claims 1-59 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over co-pending Application No. 10/451,409 in view of U.S. Patent 4,927,627. Applicant respectfully traverses this provisional rejection, at least because no actual double patenting circumstance can arise until a patent issues from the cited application. Since the above co-pending application is still under consideration, there is the possibility that the claims therein may change. Applicant further requests that any resolution in the form of a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c), if necessary, be deferred until such patent issues. Accordingly, Applicant respectfully requests that the Examiner withdraw this provisional rejection of the claims.

Applicant also notes that M.P.E.P. § 804 addresses the situation of two co-pending applications. The section indicates that “[t]he “provisional” double patenting rejection should continue to be made by the examiner in each application ... unless that “provisional” double patenting rejection is the only rejection remaining in one of the applications. If the “provisional” double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the “provisional” double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.” Applicant submits that in view of the foregoing remarks, the provisional double patenting rejection would be the only rejection remaining in this application. For at least this additional reason, Applicant requests that any resolution in the form of submission of a Terminal Disclaimer, if necessary, be deferred.

IV. CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicant's undersigned counsel at (202) 408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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